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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,175	09/12/2003	Clarence E. Thomas	068062.0168	7513

31625 7590 06/08/2007  
BAKER BOTTS L.L.P.  
PATENT DEPARTMENT  
98 SAN JACINTO BLVD., SUITE 1500  
AUSTIN, TX 78701-4039

EXAMINER
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LEE, HWA S

ART UNIT	PAPER NUMBER
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2886

MAIL DATE	DELIVERY MODE
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06/08/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/661,175

Applicant(s)

THOMAS ET AL.

Examiner

Andrew Hwa S. Lee

Art Unit

2886

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/12/03</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-8, 10, 11, 33, and 34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al (US 2002/0145773).

For claims 1 and 8, Tanaka et al (Tanaka hereinafter) show a hologram recording apparatus and method comprising:

- an illumination lens operable to focus a reference beam;
- a beam splitter (13) optically coupled to the illumination lens by the reference beam; and
- a reference mirror (45) located at a waist of the reference beam.

Although Tanaka may not expressly state the functional use of the elements, such as the use of word “operable”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. As presently claimed, there is no structural difference.

With regards to the limitation “to eliminate the need for a reference objective on a reference arm,” that limitation does not further define the structure of the holography system .

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In addition the intention of using a reference mirror to eliminate the need for a reference objective does not further define the structure of the system. Tanaka shows a structure of an illumination lens, a beam splitter, and a reference mirror located at a waist of the reference beam.

With regards to the method claim 8, "eliminating the need for..." only states the purpose or the capability of the reference mirror which is not a step. Therefore, there is no difference to the steps of the method claim. Tanaka shows the step of focusing a reference beam with an illumination lens, the step of transmitting at least a portion of the reference beam through a beam splitter, and the step of reflecting the portion of the reference beam.

With regards to claim 2, Tanaka only shows a schematic drawing of a beamsplitter and does not expressly state to use a cube beam splitter. Official Notice is taken that cube beam splitters are well known in the art and at the time of the invention one of ordinary skill in the art would have used a cube beam splitter since a cube beam splitter is notoriously well known for splitting beams.

With regards to claim 3, Tanaka shows a  $\frac{1}{4}$  wave plate (paragraph [0101]).

With regards to claim 5, Tanaka shows the reference mirror comprises a flat mirror (45).

With regards to claims 6 and 11, Tanaka shows the reference mirror operable to maintain optical symmetry of a reference arm and a target arm.

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With regards to claims 7 and 10, Tanaka shows the reference mirror operable to form a first wavefront substantially similar to a second wavefront formed by the reference objective. (paragraph [0059])

With respect to claim 33, the claim does not further limit claim 8 drawn to a method by reciting a step or manipulatively further defining a previously recited step. The claim merely recites a capability ("operable to") of the reference mirror, and thus Tanaka meets the limitation of claim 33.

With respect to claim 34, the claim does not further limit claim 8, which is drawn to a method, by reciting a step or manipulatively further defining a previously recited step. The claim merely recites the structure of the reference mirror, and thus Tanaka meets the limitation of claim 34.

3. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka as applied to claims 1 and 8 above, and further in view of Zgonik (US 6,781,725).

Zgonik shows confocal holographic optical storage having reference mirror at the waist of the reference beam wherein the laser beam (and thus the reference beam too) is a Gaussian beam (column 4, lines 36+). At the time of the invention, one of ordinary skill in the art would have used a laser source emitting a Gaussian beam for the properties such as least dilation by refraction.

### ***Response to Arguments***

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In view of the amendment to claims 1 and 8, the rejection under U.S.C. 112, second paragraph is withdrawn.

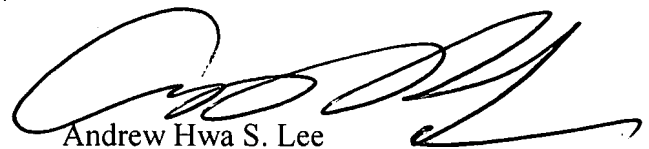
In response to applicant's argument that "eliminating the need for..." distinguishes from Tanaka, a recitation of the "eliminating the need for" is reciting the purpose, intended use, or the capability of the reference mirror. For claim 1, which is drawn to structure, there is no structural difference between the claimed invention and the prior art. There must be a structural difference in order to patentably distinguish the claimed invention from the prior art. Similarly, claim 8, which is drawn to a method, there is no difference to the method steps.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Hwa S. Lee whose telephone number is 571-272-2419. The examiner can normally be reached on Tue-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tarifur R. Chowdhury can be reached on 571-272-2800. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Andrew Hwa S. Lee', is positioned above the printed name.

Andrew Hwa S. Lee  
Primary Examiner  
Art Unit 2886